

REMARKS

The present invention relates to a cryogenic canister for biological specimens. The canister includes a box having both a lid and a base.

The base has a bottom wall and a base sidewall which extends outwardly from the bottom wall around its entire outer periphery. Similarly, the lid has a top wall and a lid sidewall which extends outwardly from the top wall around the entire outer periphery of the top wall. Furthermore, this lid is dimensioned so that the lid sidewall overlies the base sidewall and forms a box having an interior chamber which is adapted to contain biological specimens. In order to secure the lid and base together, a pair of U-shaped clips are provided on opposed sides of the box so that one leg of each clip overlies the top wall while the other leg of each clip overlies the bottom wall. Additionally, both the lid and base are made of a cardboard construction.

Claim 1 forms the only independent claim in the instant application. Claim 1, however, clearly defines the construction of the lid and base so that the lid sidewalls overlie the base sidewalls. Furthermore, claim 1 clearly defines the construction of U-shaped clips which hold the lid and base together and that the lid and base are made of cardboard.

The Patent Examiner, however, has rejected claim 1 and its two dependent claims 2 and 3 as unpatentably obvious under 35 U.S.C. §103 over U.S. Patent No. 3,231,076 to Freiman. However, for the reasons discussed below, Applicant respectfully submits that this basis for rejection is in error and should be withdrawn.

More specifically, the Freiman patent is merely directed to a clip which secures housewares together and includes a middle body section 22 which is positioned between the housewares in order to space the housewares apart from each other. Indeed, the title of the Freiman patent is "Spacer Retaining Clip". This, of course, is exactly the opposite from

Applicant's invention in which the sidewalls of both the lid and the base overlap each other and form an interior chamber in which the biological specimen is contained. In sharp contrast to this, in Freiman there are absolutely no overlapping sidewalls nor do the spacer clips 12 hold the housewares together as required by claim 1 of the instant application.

Furthermore, it would not be obvious to modify the Freiman patent to obtain Applicant's claimed invention. To do so would require that the spacer section 22 of Freiman be removed so that the housewares 11a and 11b of Freiman could have overlapping sidewalls of some sort.

However, to modify the Freiman patent by removal of the middle wall 22 would render the Freiman patent inoperable for its intended use, namely holding housewares 11a and 11b in a spaced-apart relationship. The law is well settled, however, that a modification to a prior art reference which renders that reference inoperable for its intended use cannot be obvious under the purview of 35 U.S.C. §103.

For example see *Diamond International Corp. v. Waltherhoefer et al.*, 159 USPQ 452 (D.C. Md. 1968) in which the court stated:

The court has been referred to no authority for the proposition that, and has a presently insuperable difficulty in understanding how, a device which requires a modification making it unworkable suggests such a modification in any field, let alone an unrelated one.

Diamond at 460-461. From *Diamond* it is clear that where the suggested modification to the prior art reference renders that reference inoperable, such a modification would not be obvious in any field, let alone an unrelated one.

Similarly, where the suggested modification alters the mode of operation of the prior art device so that it does not function in its intended manner, the suggested modification cannot be

obvious under 35 U.S.C. §103. This particular issue was addressed by the Patent Office Board of Appeals in *Ex parte Weber*, 154 USPQ 491 (1967), in which the Board stated:

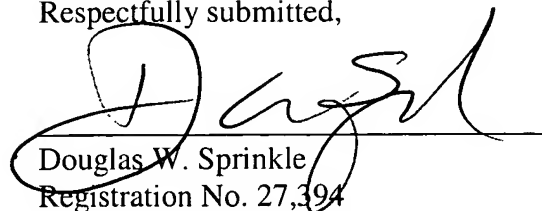
It is our opinion that the cited prior art does not teach that it would be obvious to rearrange the machine of Hempel et al. as proposed by the examiner. To do so, would completely alter the construction and mode of operation of the stencil cutter of Hempel et al., so that it would not function in its intended manner. It appears to us that the obviousness of the proposed changes is not derived from the prior art, but only from appellant's disclosure.

Ex parte Weber at 492.

In this case, the removal of the central wall 22 of Freiman and thus obtaining Applicant's invention as claimed would so modify the mode of operation of the Freiman device that it would not function in its intended manner. As such, such a modification cannot be obvious under 35 U.S.C. §103.

In view of the foregoing, Applicant respectfully submits that this case is in condition for allowance and such action is respectfully solicited.

Respectfully submitted,



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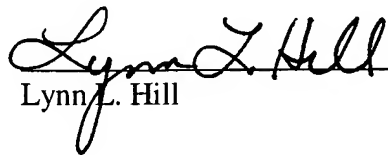
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